

REMARKS

Claims 1-14, and 22-27 are pending in the application after entry of this amendment. Claims 1-21 were previously variously rejected under 35 U.S.C. § 103 as obvious over Sheflott in view of Tibbetts and Flores. By this amendment claims 15-21 have been canceled; Independent claims 1 and 8 have been amended to more particularly point out the invention; and new Claims 22-27 have been added.

For at least the reasons stated below, Applicant urges that all claims currently presented are now in condition for allowance.

A. The Present Invention

In one aspect, the present invention provides a facility for bringing together parties on one hand who desire contract manufacturing services, and manufacturers on the other hand. A database contains information about a plurality of potential providers and the various services they offer. Users can: query the database to obtain information regarding the various providers; view various information regarding the contract manufacturing services they provide, their qualifications, etc.; use links to obtain additional information; and select a desired provider based at least in part on the information contained within the database regarding the services offered by that provider. The invention is particularly useful in allowing pharmaceutical companies to search among various fine chemical contract manufacturers based on the services they provide and other salient criteria, and select a particular manufacturer to manufacture extremely pure chemicals for them.

B. The Prior Art

(i) Sheflott, et al. (U.S. Patent No. 5,802,493)

Sheflott is the primary reference relied upon in making all of the claim rejections, but is completely unlike the present invention. Sheflott relates to "a method and apparatus for generating responses to questionnaires." See Technical Field section. Sheflott purports to disclose a system for automatically generating answers to questionnaires using a database populated by pre-written question-and-answer pairs. The system receives questions such as the questions asked of a medical services provider when an employer is seeking to find a medical insurance provider, and searches the database to see whether a similar question has been asked. If yes, then the system prints out the question-and-answer pair so that the user can determine whether the "canned" answer provided comes close enough to answering the question asked and therefore can be used in responding to the questionnaire,

or whether manually amending of the answer is necessary. See, e.g., Abstract; col. 5, lines 19-36.

Sheflott does not assist in selecting from among a plurality of manufacturing service providers, or even in selecting from among a plurality of any service providers in a database. Rather, Sheflott only assists in determining whether a company should bid for a particular health insurance proposal. For example, Sheflott purports to help a company "see whether or not the prospect company [a company which is seeking health insurance for its employees] and its employees geographic locations are an appropriate match for the doctors and other health care providers that are associated with the proposed [health insurance coverage] plan" using a ZIP code matching system to compare employees' ZIP codes to doctors' ZIP codes. Col. 6, lines 57-66. If the match is not a good match, then it is not appropriate for the insurance company to compete for that employer's business. Col. 6, line 66 – col. 7, line 3. In sum, Sheflott only teaches a system for preparing questionnaire responses and seeing whether or not it is worth bidding for a health insurance contract. This has nothing to do with selecting a particular manufacturer or service provider from among a plurality of potential contract manufacturers, to which the present invention is directed.

Furthermore, one seeking a solution to the problem of selecting a particular contract manufacturer from among the universe of possible contract manufacturers, to which the present invention is directed, would not turn for a solution to systems of generating answers to health insurance questionnaires.

However, in order to more clearly distinguish over Sheflott the claims have generally been amended to recite that the system facilitates a user to select a *particular* provider from among a *plurality* of providers.

(ii) Tibbetts (U.S. Patent No. 6,158,044)

The Examiner has relied on Tibbetts in rejecting all of the claims. The Examiner contends that Tibbetts teaches "utilizing a contract-proposal mechanism." Office Action, page 3.

Tibbetts is not pertinent to the present invention. Tibbetts purports to introduce a software notion of a "proposal" object, which is a software object that de-couples the front-end of a computer (e.g., mouse click, keystroke) from the back end (e.g., an action on a memory such as file read action or file write action). See, e.g., Figs. 3, 4, and 7; col. 1 line 60 – col. 2, line 11. As explained by Tibbetts:

A Proposal is accessed via one or more User Interfaces (UI). This breaks the close coupling between the front-end and the back-end, thereby allowing the user to add a Web interface or Graphical User Interface (GUI) or other kind of front-end without having to rewrite the back-end [software] application.

Abstract. Tibbetts does not teach or relate in any way to a "contract-proposal" mechanism as asserted by the Examiner. Although a software programmer might turn to Tibbetts for Tibbetts' teaching of a way to de-couple the front-end and back-end of a computer, Tibbetts has nothing to do with economic contracts and contract manufacturing, to which certain recited aspects of the present invention are directed. Therefore, the claims have generally been amended to clarify that the invention relates to "contract manufacturing services," thus clearly distinguishing over Tibbetts' software construct and rendering Tibbetts irrelevant and inapplicable to the invention as now claimed.

(iii) Flores et al. (U.S. Patent No. 6,073,109)

Flores is very different from the present invention. Flores purports to disclose a system for scheduling tasks that the user must perform, and then prompting him at appropriate points along the way to accomplish those tasks. According to Flores, the system "i) notifies the user that he or she has a step to begin or to complete; ii) provides the user with the proper tools to complete a task; iii) provides the user with the proper information to complete a task; iv) allows the user to see where a task fits in the overall process; v) manages proper reminders, alerts, and follow-ups to keep the process moving; vi) automates certain standard procedures; vii) integrates with the organization's existing business systems; and viii) provides application program interfaces that allow developers to develop applications that are work-flow enabled." Abstract. Flores has nothing to do with providing a database and query tools that allow potential purchasers of contract manufacturing services to review and select from among a plurality of contract manufacturers based upon their characteristics and the services they offer.

Additionally, someone seeking a way to improve the process by which manufacturing was outsourced would not turn to a software program whose primary purpose is to generate automatic reminders to the user.

(iv) Elance (printout dated 06/05/2002 from www.elance.com)

The Examiner has relied on Elance in rejecting a number of claims in the application. The burden of establishing that a reference constitutes "prior art" which is accessible to the public rests on the Office. Carella v. Starlight Archery, 804 F.2d 135, 231 U.S.P.Q. 644 (Fed. Cir. 1986). The Elance reference is dated June 5, 2002. It is unusable as a reference

against the current application, which was filed more than two years earlier on April 27, 2000. The Examiner appears to have considered the Elance reference as having an effective date of 1999 based on the copyright notice on the printout, which states "© 1999-2002 Elance Inc. All rights reserved." There is, of course, no way of knowing from the printout what was posted on the Elance website in 1999, or even if anything at all was posted on the website prior to the filing of the present application. Under the copyright laws, one does not need to have made a public disclosure in order to claim a copyright date. rather, one merely needs to have created "a work of authorship fixed in any tangible medium of expression," such as on the back of a napkin. 15 U.S.C. 102(a). That is, the copyright date is not necessarily the publication date. Unless the Examiner can prove the publication date, the Internet printout is not usable as a reference. MPEP 2128.01 ("If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b), although it may be relied upon to provide evidence regarding the state of the art.")

A copyright date is not a publication date. Therefore, even if one assumed for arguments sake that all of the material on the Elance.com website is entitled to a copyright date of 1999 (and it is clear that Elance does not contend that all of the material on the website is entitled to a 1999 copyright date because the copyright date is listed as 1999-2002), that still does not satisfy the Office's burden of establishing that the June 5, 2002 printout cited by the Examiner constitutes prior art usable against this application.

C. 35 U.S.C. § 103 Rejections

All previously presented claims 1-21 were rejected under 35 U.S.C. § 103(a) as obvious over Sheflott in view of Tibbetts and Flores.

Claim 1

The preamble to Claim 1 as amended states that the invention is "in a contract manufacturing framework." This alone makes the claim distinguish over the references, because none of the references have anything to do with a contract manufacturing framework.

Claim 1 as amended further recites:

(a) providing a database including a plurality of service provider data structures, wherein each service provider data structure includes a description of a particular service provider and contract manufacturing services provided

by the service provider, and wherein the database further includes a plurality of links to information;

(b) identifying a particular service provider data structure;

(c) identifying a particular link based on the request data;

(d) sending the user the identified service provider data structure and so as to identify to the user a particular service provider, and sending the user the identified link;

(new limitations are underlined). The Examiner had previously stated that, "Sheflott teaches a method for providing a contract services in a framework comprising the steps of matching a user to a service provider utilizing a database having information on service providers (Abstract)(Fig 1/31/36/30) (Fig 3/88)(col. 6 lines 55-62). . . " Office Action, page 2.

Applicant respectfully disagrees. Sheflott relates to a "method and apparatus for generating responses to questionnaires." (Technical Field section). Sheflott purports to disclose a system which:

receives questions propounded in a [health insurance] Request for Proposal in a manner that allows for comparison with each received question with a database of stored questions. . . . [The disclosed system is a] system which [returns] similarly worded questions in accordance with a predetermined match threshold between the text and input parameters associated with the question [and which] enable[s] a respondent to select an associated answer for inclusion in the final response document.

(col. 3, lines 46-55). Sheflott relates only to matching up questions and answers regarding health care services provided by a single provider entity, so as to produce semi-automated answers to health insurance questionnaires that need only a minor amount of manual adjustment. See Abstract.

Nevertheless, Applicant has amended claim 1 to clearly recite that the database includes a "plurality of service provider data structures," a "description of a particular service provider and contract manufacturing services provided by the service provider," and that the claimed method includes the step of "sending the user the identified service provider data structure so as to identify to the user a particular service provider, and sending the user the identified link." Claim 1 as amended clearly distinguishes over the prior art because Sheflott does not relate to allowing a user to identify a particular contract manufacturing service provider from among a plurality of contract manufacturing service providers as claimed.

The Examiner had also stated that Sheflott discloses "providing a supply chain/workflow services and a database for services provided by the service providers and identifying a particular service provider based on the request data (col. 6 lines 32-52)(col 6 lines 62 - col 7 line 3)." Office Action, page 2.

Initially, Applicant points out that the applicant does not claim "providing a supply chain/workflow services," so the citation by the Examiner is not relevant. In any event, Applicant disagrees. The cited passage merely discloses "calling around" within a company to find the correct answers to questions in a questionnaire, having the answers reviewed by the Legal Department, updating a paper manual with the new question/answer pairs, sending the completed questionnaire back to a consultant, and comparing employees' zip codes to doctor and health care locations to determine whether it is appropriate to bid to provide health insurance to a particular company and its employees who need health care. (col. 6 lines 32-52, and col. 6 line 62 – col. 7 line 3).

The Examiner also contends that Shefflott teaches "allowing the user access and query for technical services concerning services provided by the service providers utilizing the database(col 23 lines 22-30)." Office Action, at p. 3. Applicant respectfully disagrees. The cited passage reads in its entirety:

Once all of the searching apparatus data files have been rebuilt, the apparatus copies all of the rebuilt files to a maintenance specific storage volume. Thereafter these files are copied in a batch mode. The system only copies those files that have been created after a certain date that is specified before execution. Other copies of the searching apparatus files are created as needed in a wide area or local area networks which are accessed by the various respondents and maintenance personnel.

(col. 23, lines 22-30). As one can see, the cited passage says nothing about querying for technical services.

The Examiner further contends that "Flores teaches providing transaction services to the user (Fig 4c)(Fig 4b)(Fig 4a)(col. 110 lines 27-64)." Flores does not relate to economic transactions such as manufacturing contracts as claimed, but relates only to allowing a user to enter into a computer program reminders that the user should perform certain tasks, and then reminding the user to perform those tasks. See Abstract. The "transactions" referred to in Flores relate not to economic transaction such as manufacturing contracts; rather, the

"transactions" is lingo for any actions taken at the instance of another, such as in Flores' example, "John asked Frank to prepare the report and deliver it by noon on Friday." (see col. 1 lines 56-64, and col. 2 lines 16-17). Even if Flores' transactions did relate to economic transactions such as manufacturing contracts as claimed, that would not be relevant to the application which does not claim "transaction services."

The Examiner further contends that "Tibbetts teaches utilizing a contract-proposal mechanism (Fig. 5)(Fig. 7) (Fig. 6)." Applicant respectfully disagrees. As discussed more fully above, Tibbetts relates only to a software construct which Tibbetts calls a "proposal," and is in fact a means to decouple front-end computer operations (e.g., keystrokes and mouse click selections) from back-end operations (e.g. file read and file write operations). (Summary of the Invention, col. 1, line 60 – col. 2, line 23). Tibbetts does not relate in any way to proposals for legal contracts. In any event, the claims do not recite a proposal mechanism, so the citation to Tibbetts is not pertinent.

Claim 2

Claim 2 recites that "the service provider data structures further include data concerning contract service providers."

In rejecting claim 2 under 35 U.S.C. 103(a) over Sheflott in view of Tibbetts and Flores, the Examiner contends that, "Sheflott teaches . . . [that] the step of matching the user to a service provider includes optimization services"; that "Tibbetts teaches coordinating actions between proposal and any consumer which leads to optimization services"; and that "Flores teaches workflow management and workflow schedule processing (Fig. 2) and performance optimization (Fig. 1) and satisfaction optimization (Fig. 3)." Office Action, page 3.

The Examiner appears to have this application confused with another application, as the contentions by the Examiner, even if true, do not bear on claim 2 as written. Accordingly, applicant respectfully submits that the rejection was improper.

Claims 3-5, and 10-12

The Examiner has relied on Elance in rejecting claims 3-5 and 10-12 under 35 U.S.C. 103(a). As stated in detail above, the Elance printout dated 2002 is unavailable as a prior art reference against this application, which was filed in 2000. Accordingly, the rejection of claims 3-5 and 10-12 should be withdrawn for at least that reason.

Claims 8 and 22

Independent claim 8 and newly added independent claim 22 are similar to claim 1, and patentably distinguish over the references cited for at least the reasons stated with respect to claim 1.

Claims 2-7, 9-14, and 23-27

Claims 2-7, 9-14, and 23-27 depend from claims 1, 8, and 22, respectively, and are allowable for at least the reasons stated with respect to those independent claims.

CONCLUSION

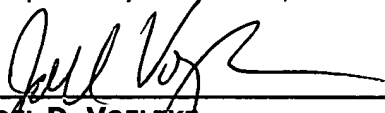
The present invention is directed very specifically to methods for providing access to contract manufacturing services which enable a user to search a database of contract manufacturing service providers and, based on the user's query, receive information regarding a contract manufacturing service provider of potential interest.

In rejecting the application, the Examiner has relied upon: a software program for recalling canned answers to previously asked questions regarding health care insurance and thus generating responses to a questionnaire (Sheflott); a software construct for decoupling a front-end user interface from the back-end of a computer that has nothing to do with contracts or other economic transactions (Tibbetts); a computer program for generating reminders to the user to perform scheduled tasks (Flores); and a reference dated more than two years after the application was filed (Elance.com). The invention is much different from these references from both a common sense perspective, as well as a legal analysis of the claim language versus the references. The claims as currently presented now clearly and patentably distinguish over the references, taken either singly or in any combination.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 310-319-5459 x100. If any additional fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees, including fees for any extension of time, to Deposit Account No. 50-1901 (reference 60021-358401).

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Respectfully submitted,



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